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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/967,646	10/28/92	STAVRIANOPoulos	J ENZ7 (C2) (
		18N1/0725	MARSCHEL, A EXAMINER
RONALD C. FEDUS ENZO DIAGNOSTICS, INC. ENZO BIOCHEM, INC. 575 FIFTH AVENUE (18TH FLOOR) NEW YORK, NEW YORK 10017		ART UNIT	PAPER NUMBER
		1807	12
DATE MAILED: 07/25/94			

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

Amdt C (4-22-94)

This application has been examined       Responsive to communication filed on IDS(6-2-94)  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449. (5 sheets)
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 27-47 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 1-26 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 27-47 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other \_\_\_\_\_

EXAMINER'S ACTION

Applicant's arguments and IDS, filed 4/22/94 and 6/2/94, respectively, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

If applicant desires priority under 35 U.S.C. § 120 based upon a parent application, specific reference to the parent application must be made in the instant application. It is noted that this appears as the first sentence of the specification following the title. Status of the parent application (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "Patent No." should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application.

A copy of the executed PTO Form 1449 is enclosed. Several references listed thereon are lined through as not having been considered because no copy of these references has been supplied.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 27-45 are rejected under 35 U.S.C. § 101 because there is no instantly disclosed utility for the double-stranded containing composition. This rejection is reiterated and maintained as set forth in the previous office action mailed 10/22/93. Applicants argue that the double-stranded form is an intermediate prior to detection. This is non-persuasive in that

this utility has not been found in the disclosure as filed. Adding it at this time does not support the utility of the invention as disclosed. Also applicants argue that double-stranded form passes the strictures of utility irrespective of whether detection has been carried out. This is confusing and non-persuasive because the Examiner is unaware of such an inherent utility in double-stranded nucleic acid.

Claims 27-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of U.S. Patent No. 4,994,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons of record and not argued. Applicant has filed a terminal disclaimer which is being charged for its fee and under review regarding completeness. This rejection will be reviewed and withdrawn if appropriate after that review process is complete which should be complete shortly.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL

ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CMI Fax Center number is either (703) 305-3014 or (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Margaret Parr, can be reached on (703) 308-2454.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

AM A. MARSCHEL:am

July 25, 1994

MARGARET PARR  
SUPERVISORY PATENT EXAMINER  
GROUP 1800

*M. Parr 7/25/94*